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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,663	04/11/2001	Anthony J. Polak	LFS-5044	1850

27777 7590 05/18/2005

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EXAMINER

YANG, NELSON C.

ART UNIT PAPER NUMBER

1641

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding:

<b>Office Action Summary</b>	<b>Application No.</b> 09/832,663	<b>Applicant(s)</b> POLAK ET AL.	
	<b>Examiner</b> Nelson Yang	<b>Art Unit</b> 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/05</u> <u>3/14/05</u>   | 6) <input type="checkbox"/> Other: _____                                    |

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## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment of the specification is acknowledged and has been entered.
2. Claims 1-43 are currently pending.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 21, 22, 27, 28, 33, and 44-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 21, 22, contain the trademark/trade names Alkali Blue, Safranin, and Pararosaliline. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe quenching dyes and, accordingly, the identifications/descriptions is indefinite.

6. Claims 27, 28, and 33 contain the trademark/trade names ALEXA-488, ALEXA-633, and Cy-5. Where a trademark or trade name is used in a claim as a limitation to identify or describe

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a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe label and reference dyes and, accordingly, the identification/descriptions are indefinite.

7. Claim 44 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the steps that specify how deeply the device may be implanted. From the specification, it appears that the device may only be implanted just under the surface of the skin (p.5, lines 1-18). In addition, it is unclear how the detection of light would correlate with the presence of analytes, particularly since the device of claim 1 also contains a reference dye, which would presumably also emit light, regardless of the presence of analytes.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1-17, 19-20, 23-26, 29, 34-47 are rejected under 35 U.S.C. 103(a) as being anticipated by Schultz [US 6,256,522] in view of Krauth [US 4,954,435].

With respect to claim 1-4, 7-8, 19, 20, 23-26, 29, Schultz teaches a receptor material, Concanavalin A covalently attached to Rhodamine dye molecules, analog analyte comprising dextran covalently attached to fluorescein dye molecules located within a transparent capsule comprising a semi-permeable membrane comprising cellulose or polysulfone (column 10, lines 21-37, claim 1). Schultz further teaches a pH indicator located within the capsule (column 11, lines 1-5, claim 1), as well as a second dye of a second wavelength different from the first wavelength (column 13, lines 15-20). The rhodamine quenches emission fluorescence from the fluorescein (column 10, lines 38-45). With respect to claim 4, the receptor material may be immobilized to a gel such as polyethylene glycol within the chamber (column 8, lines 11-27). Schultz fails to specifically teach using the pH indicator or a second dye as a reference dye.

Krauth, however, teaches that in fluorescence assays, using a ratio of light signals, one signal being the reporter signal, and the other being the reference signal, provides a correction mechanism for obviating such variables such as fluctuation in the lamp output, variation in tube position, diameter, or optical quality (column 3, lines 50-61).

Therefore it would have been obvious to use the pH indicator as a reference dye as suggested by Krauth in the device of Schultz et al, in order to obviate such variables such as fluctuation in the lamp output, variation in tube position, diameter, or optical quality when detecting the presence of analytes.

10. With respect to claims 5-6, although neither Schultz nor Krauth teaches a reference covalently bonded to the membrane or in the membrane, it would have been obvious to one

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having ordinary skill at the time was made to have the reference covalently bonded to the membrane or in the membrane, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, USPQ 70.

11. With respect to claims 9-12, Schultz teaches that the analyte and receptor may bind to form an analyte-receptor complex (column 6, lines 40-50) and comprise dextran (column 10, lines 20-37).

12. With respect to claims 13-17, Schultz teaches that the receptor material can be immobilized to a gel such as polyacrylamide (column 8, lines 20-28). Schultz further teaches that rhodamine dye molecules can be attached to the receptor material for quenching fluorescence (column 10, lines 25-45).

13. With respect to claims 34-36, Schultz teaches that the semi-permeable membrane comprising cellulose or polysulfone (column 10, lines 21-37, claim 1)

14. With respect to claim 37, Schultz teaches that the analyte-permeable membrane may also have a reflector comprising metallic particles immobilized on the surface of an ultrafiltration membrane (column 10, lines 1-10).

15. With respect to claims 38-39, Schultz teaches that the analyte being measured is glucose (column 10, line 25).

16. With respect to claims 40-43, while Schultz do not teach what the ratio of the empty space encapsulated by the capsule to a volume occupied by the binding substrate is, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranged involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Furthermore, since applicant has not discussed any unexpected improvements or results using

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ratios between 0.05 and 5, between 0.5 and 3, or 1, it would have been obvious to a person of ordinary skill in the art to have used ratios between 0.05 and 5, between 0.5 and 3, or 1 through normal optimization techniques.

17. With respect to claims 44-47, the sensor unit may be placed underneath the skin (column 7, lines 27-36), illuminated with a laser (column 7, lines 38-45), and measuring absorption of light, including ultraviolet, visible or infrared (column 7, lines 15-25).

18. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz [US 6,256,522] in view of Krauth [US 4,954,435], as applied to claim 1 above, and further in view of Vo-Dinh [US 5,864,397].

Schultz teaches a binding substrate, but fails to teach that the binding substrate has a molecular imprint of the analyte.

Vo-Dinh, however, teaches the use of a molecular imprint material designed to concentrate specific compounds of interest for improved sensitivity (column 6, lines 63-65).

Therefore it would have been obvious to use a molecular imprint material, as suggested by Vo-Dinh, in the device of Schultz, in order to concentrate specific compounds of interest for improved sensitivity.

19. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz [US 6,256,522] in view of Krauth [US 4,954,435], as applied to claim 1 above, and further in view of Nardone et al [US 6,531,581].

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Schultz teaches a dye that quenches the signal produced by a fluorescent label when the analyte analog is covalently attached to the receptor material, as discussed above. Schultz does not teach that the quenching dye is Alkali blue.

Nardone et al, however, do teach the use of Alkali blue as a quenching dye (column 5, line 1), since fluorescent dyes may have fluorescent emissions that will spill into assay wavelengths and increase the background noise (column 5, lines 63-67).

Therefore it would have been obvious to use non-fluorescent dyes such as Alkali blue as quenching dyes instead of a rhodamine dye molecule in the device of Schultz, as suggested by Nardone et al, in order to prevent fluorescent emissions that would spill into assay wavelengths, thus increasing the background noise.

20. Claims 27, 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz [US 6,256,522] in view of Krauth [US 4,954,435], as applied to claim 1 above, and further in view of Ferri et al [Ferri et al, Direct eye visualization of Cfluorescence for immunocytochemistry and in situ hybridization, 2000, J Hist Cytochem, 48(3), 437-444]

Schultz and Krauth teach the use of a reference, as discussed above, but do not teach the use of cyanine dyes such as Cy5.

Ferri et al, however, teach that Cy5 provides a distinct fluorescent signal that can easily be separated from that of many other fluorochromes (p.437, col.1). Ferri et al further teach that a distinct advantage of Cy5 is the low autofluorescence found in many cells and tissues in the above wavelength range (p.437, col.1).



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Therefore, it would have been obvious to use Cy5 as a reference in the device of Schultz and Krauth, as suggested by Ferri et al, in order to provide a distinct fluorescent signal that can be easily separated from other fluorochromes.

21. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz [US 6,256,522] in view of Krauth [US 4,954,435], as applied to claim 1 above, and further in view of Panchuk-Voloshina et al [Panchuk-Voloshina et al, Alexa Dyes, a series of new fluorescent dyes that yield exceptionally bright, photostable conjugates, 1999, J Hist Cytochem, 47(9), 1179-1188].

Schultz and Krauth teach the use of a reference as discussed above, but do not teach the use of ALEXA FLUOR dyes such as ALEXA 488.

Panchuk-Voloshina et al, however, teach that ALEXA dyes yield the most stable conjugates and allows reactions to take place efficiently at pH 7.5-8.5 or at even lower pH when required (p.1180, col.1).

Therefore it would have been obvious in the method of Schultz to substitute the fluorescein label with ALEXA 488, as taught by Kumar et al, since it has been demonstrated to be more immunofluorescence than fluorescein for conventional immunofluorescence.

22. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz [US 6,256,522] in view of Krauth [US 4,954,435], as applied to claim 1 above, and further in view of Bruchez et al [US 6,274,323].

Schultz and Krauth teach the use of a reference, as discussed above, but fail to teach the use of quantum dots as a reference.

Bruchez et al, however, teach that semiconductor nanocrystals may be used to detect or track a single target, and can be used to in a variety of assays where other, less reliable, labeling methods have typically been used, including fluorescence microscopy, histology, cytology pathology, flow cytometry, FISH, signal amplification assays, DNA and protein sequencing, immunoassays, immunohistochemical analysis, homogeneous assays, high throughput screening, and the like (column 16, lines 58-67).

Therefore it would have been obvious to use semiconductor nanocrystals, or quantum dots, instead of a label as a reference in the device of Schultz, as suggested by Bruchez et al, in order to provide a more reliable labeling method.

### *Double Patenting*

23. Claims 1-3, 7-10, 19-22, 25-26, 29-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 6,454,710. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent teaches labeled analogues which bind reversibly to a substrate, located within a support, a membrane comprising cellulose acetate (claim 22) that is permeable to an analyte and substantially transparent to excitation wavelengths and emission wavelengths, a dye which absorbs a majority of the excitation and emission wavelengths of the fluorescent label, and a reference (claim 1). Therefore, it would have been obvious that the invention of U.S. Patent No. 6,454,710 is not patentably distinct from the instant invention. The labeled analogues can be glucose analogues (claim 40) and comprise Concanavalin A (claim 14), quantum dots, tracer dyes, and phycobiliproteins (claim 17). The substrate can contain dyes selected from Alkali Blue 6B, Azure A, Evans Blue, and Celestine blue (claim 15).

Therefore, it would have been obvious that the invention of U.S. Patent No. 6,454,710 is not patentably distinct from the instant invention.

24. Claims 1-43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-55 of U.S. Patent No. 6,379,622. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent teaches an analyte permeable membrane that encapsulates a labeled analogue, a reference comprising quantum dots, a dye bound to a binding substrate with an absorption spectrum that has an absorption spectrum that overlaps the excitation and emission spectra of the label (claim 1).

#### ***Response to Arguments***

25. Applicant's arguments on page 10, with respect to the rejection of claims 21, 22, 27, 28, and 33, under 35 U.S.C. 112, second paragraph, have been fully considered but they are not persuasive. Applicant appears to acknowledge that Alkali Blue, Safranin and Pararosaliline are trade names, and therefore the rejections are maintained, as they apply to trade names as well as trademarks.

26. Applicant's arguments with respect to the rejections under 35 U.S.C. 103(a) as being anticipated by Schultz [US 6,256,522] in view of Krauth [US 4,954,435] have been fully considered but they are not persuasive.

27. In response to applicant's arguments on pages 11-12, against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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In particular, while applicant's arguments that nothing in the Schultz reference teaches or suggests the desirability of combining a detector with a reference wherein the detector and the reference have two distinct emission is noted, Schultz does teach the use of two different dyes with different wavelengths (column 13, lines 9-22). With respect to applicants arguments on p. 12 regarding Krauth, it should be noted that Krauth merely provides the motivation to use the second dye as a reference dye.

28. With respect to applicant's arguments on page 12, that neither Schultz nor Krauth teach or suggest an analyte permeable membrane that is transparent to light at wavelengths that excite the label and the reference, it should be noted, as discussed above, that Schultz teaches a transparent capsule (column 10, lines 30-31), and teaches that multiple dyes may be located in the capsule, each with a different wavelength (column 13, lines 15-22). It should also be noted that applicant does not claim a reference with a different excitation wavelength than the label, as applicant merely claims a reference with a different emission wavelength than the label (claim 1). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

29. This is also applicable to applicant's arguments on p. 13 that Schultz does not discuss a seamless device.

30. With respect to applicant's arguments that Krauth does not teach or suggest the use of any analyte permeable membrane, it should be noted that Krauth merely provides motivation for using the second dye in the device of Schultz as a reference dye with a different wavelength.

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31. Applicant's arguments on page 14, with respect to the rejections of the claims under the judicially created doctrine of obviousness-type double patenting with respect to U.S. Patent No. 6,454,710 and U.S. Patent No. 6,379,622 have been fully considered but they are not persuasive.

Applicant argues that U.S. Patent No. 6,454,710 does not include an analyte permeable membrane that is transparent to light of the wavelengths that excite the label and the reference. Examiner disagrees. U.S. Patent No. 6,454,710 recites a membrane permeable to the analyte and impermeable to the labeled analogue, that is transparent to each of the excitation wavelengths and an emission wavelengths of a fluorescent label (column 14, lines 25-30) and also teaches a reference (column 14, lines 35-36) with an excitation wavelength that is the same as the excitation wavelength of the fluorescent label (claim 16). Therefore the membrane would be transparent to the excitation wavelengths of both the fluorescent label and the reference.

Applicant argues that U.S. Patent No. 6,379,622 teaches a patentably distinct invention from the instant application and asserts that claim 1 of the patent teaches a support having an interior surface and an exterior surface and a substrate connected to the interior surface of the support. However, it is unclear how this would render the patent patentably distinct from the application as the invention would not preclude a support having an interior surface and an exterior surface and a substrate connected to the interior surface of the support.

### *Conclusion*

32. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

33. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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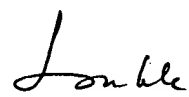
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson Yang whose telephone number is (571) 272-0826. The examiner can normally be reached on 8:30-5:00.

35. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nelson Yang  
Patent Examiner  
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05/15/05